

RCE application. These are:

(1)

On page 4, lines 4-6, the Board states:

Clearly the examiner is relying upon the "steel plate" or flanged-shaped member (1) as shown in Figure 4 as the starting point in the method of Kanemitsu...

Claim 5, however, does *not* start with a flanged-shaped member like that of Figure 4 of Kanemitsu. Claim 5 starts with the step of "holding the sheet metal member and forming from the sheet metal member a base plate, a stepped portion and a flanged-shaped portion.." If claim 5 were starting with a flanged-shaped member like that of Figure 4 of Kanemitsu, then the recited first step of claim 5 would be meaningless. Formation is a positively recited method step. Existence, which is what we have with Figure 4 of Kanemitsu is not. Examination of the positively recited steps in a claim cannot be rendered meaningless by the examination. The fact is that claim 5 begins with what is shown in Fig. 1 of the present application, and such an orientation simply cannot be known from Kanemitsu. Kanemitsu does not tell us how the configuration of Figure 4 was achieved, and we are not permitted to assume that it was done according to the present invention. Such a conclusion assumes too much.

The rejection is anticipation under 35 USC 102 for claim 5. This section of the law does not permit us to assume what a reference teaches, it must specifically tell us what it teaches. There are any number of ways to arrive at the shape shown in Figure 4 of Kanemitsu. Since claim 5 is a method claim, how the part is made is paramount, not what it looks like.